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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	78602188
Applicant	Healthcare Distribution Management Assoc iation
Applied for Mark	HEALTHCARE DISTRIBUTORS INTERNATIONAL
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Date	07/12/2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Application Serial No.:	**78602188**
Application Filing Date:	April 5, 2005
Mark:	HEALTHCARE DISTRIBUTORS INTERNATIONAL
Owner/Applicant:	Healthcare Distribution Management Association
Attorney's Reference:	HEAL6002/TJM

REPLY BRIEF

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ARGUMENT

I. THERE IS NO QUESTION THAT APPLICANT MAY ADD A DISCLAIMER.

The Examining Attorney's Appeal Brief does not dispute the statement on pages 14-15 of Applicant's Brief, that "Applicant should be allowed to disclaim either 'DISTRIBUTORS' or 'DISTRIBUTORS INTERNATIONAL' at Applicant's discretion." 37 C.F.R. §2.142(g) (2003).

II. THE MARK OF APPLICANT'S PREVIOUSLY ISSUED REGISTRATION HAS ACQUIRED DISTINCTIVENESS.

The Examining Attorney's Appeal Brief does not contest that the mark HEALTHCARE DISTRIBUTION MANAGEMENT ASSOCIATION for goods and services in Classes 16, 35, 38, 41 and 42, with a disclaimer of "association" has acquired distinctiveness, as indicated by the "Section 2(f)" claim printed on the face of Applicant's previously issued Registration No. 2,888,102. Moreover, this fact cannot be contested unless a cancellation is filed.

III. LEGALLY EQUIVALENT MARKS MAY BE DISTINGUISHABLE.

At page 6 of the Examining Attorney's Appeal Brief, there is the statement that "[t]he two marks, HEALTHCARE DISTRIBUTORS INTERNATIONAL and HEALTHCARE

DISTRIBUTION MANAGEMENT ASSOCIATION, are not indistinguishable ...." The standard is not whether the marks are indistinguishable.

The present intent to use mark may be approved for publication based upon the acquired distinctiveness of a previously registered mark. *In re Dial-A-Mattress Operating Corporation*, 240 F.3d 1341, (Fed. Cir. 2001); *accord*, *Trademark Manual of Examining Procedure* (TMEP) §1212.09 (April, 2005). In the *Dial-A-Mattress* case, the Federal Circuit stated as follows:

> A proposed mark is the "same mark" as previously-registered marks for the purpose of Trademark Rule 2.41(b) if it is the "legal equivalent" of such marks. A mark is the legal equivalent of another if it creates the same, continuing commercial impression such that the consumer would consider them both the same mark. Whether marks are legal equivalents is a question of law subject to our de novo review. No evidence need be entertained other than the visual or aural appearance of the marks themselves. [Citation omitted]

Id. at 1347. In the *Dial-A-Mattress* case, the held as follows:

> As the "same mark" or the "legal equivalent" of "(212) M-A-T-T-R-E-S," the "1-888-M-A-T-R-E-S-S" mark is entitled to rely on the former as *prima facie* evidence of acquired distinctiveness. ....

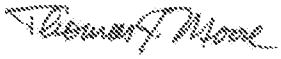
Id. at 1348 (emphasis added). Theses two marks are not indistinguishable because the first begins with the telephone area code 212 for the New York City area, while the second begins with the area code 1-888 which is toll free. Consumers would recognize the difference between two area codes, and those outside the New York City area would certainly recognize the difference between a toll free call, and a long distance call. Moreover, the terms M-A-T-T-R-E-S and M-A-T-T-R-E-S-S are highly descriptive, and just short of generic for the goods sold, which are of course mattresses.

In the present case, Applicant relies on an earlier registration of a legally equivalent mark for closely related goods and services, just as in the *Dial-A-Mattress* case. The present mark HEALTHCARE DISTRIBUTORS INTERNATIONAL begins with the words HEALTHCARE DISTRIBUTORS which are almost identical to the words HEALTHCARE DISTRIBUTION which begin the registered mark HEALTHCARE DISTRIBUTION MANAGEMENT ASSOCIATION. The marks are legal equivalents for purposes of a claim of acquired distinctiveness based on a previously registered mark.

CONCLUSION

Applicant respectfully submits that the application should be approved for publication because there is adequate evidence of acquired distinctiveness under Section 2(f) of the Lanham Act, 15 U.S.C. §1052(f) (1999).

Respectfully submitted,



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